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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,525	10/16/2001	Fred Burbank	9619-1031	8046

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,525

Applicant(s)

BURBANK ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-33 and 35-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-33 and 35-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/01;4/02;5/02-05</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statements filed 10/16/01, 4/11/02, 5/24/02 and 5/31/05 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits. However, references disclosed more than once have been lined through.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24, 25 and 26 depend from a cancelled claim. Therefore, it is impossible to interpret the scope of the claim language.

### *Double Patenting*

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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4. Claims 27 – 33 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4 - 10 of prior U.S. Patent No. 6,712,775. This is a double patenting rejection.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 35 – 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,712,775. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because claims 35 – 37 of the present application are merely broader than claim 1 of U.S. Patent No. 6,712,775 to Burbank et al. Therefore, any art meeting the limitations of claim 1 of U.S. Patent No. 6,712,775 would necessarily meet the limitations found in claims 35 – 37 of the present application.

7. Claims 35 – 43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, 9 and 17 of U.S. Patent No. 6,454,727 to Burbank et al. in view of U.S. Patent No. 6,494,881 to Bales et al.

In regards to claims 35 – 43, Burbank et al. discloses a tissue acquisition device useful in retrieving tissue samples from a patient, comprising: an Inner cannula having a proximal end, a distal end, a longitudinal axis extending between the proximal and distal ends, a tubular sidewall, a cut out in the sidewall and a main lumen extending within at least a portion of the inner cannula; an outer cannula having a proximal end, a distal end, a longitudinal axis extending between the proximal and distal ends, a tubular sidewall, a cutout in the tubular sidewall of the outer cannula and a main lumen extending within at least a portion of the outer cannula; a passageway extending longitudinally along the device from the proximal end toward the distal end; a cutting wire slidably and rotatably disposed in the passageway, having a proximal end and a distal end and having a cutting loop at the distal end which extends out of the passageway and which is configured to rotate out of the inner cannula to a position exterior to the outer cannula, to move longitudinally in a direction generally parallel to the longitudinal axis exterior to the outer cannula and to rotate from a position exterior to the outer cannula into the inner cannula (Claim 1). Burbank et al. discloses an end plug mounted at the distal ends of the inner cannula and the outer cannula (Claim 5) which comprises a cutting wire extending distally from the end plug and separated from the end plug by a gap, the cutting wire including a connecting portion embedded in the end plug, extending proximally

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through the end plug, and exiting the end plug proximally, the cutting wire including a free end opposite the connecting portion which is embedded in the end plug (Claim 8), wherein the inner cannula further comprises a conductor extending through the inner cannula sidewall from the proximal end to the distal end, the conductor having a distal end in electrical contact with the end plug cutting wire (Claim 9) Burbank et al. discloses the outer cannula comprising an electrically conductive material on a portion of the exterior of the outer cannula, and the outer cannula being a return electrode for the cutting loop. However, Burbank et al. fails to disclose the cutting wire or distal cutting wire being formed of a material selected from the group consisting of stainless steel, tungsten, platinum, and nickel-titanium alloy and being connected to a source of radio-frequency electrical energy. Bales et al. discloses a cutting wire being formed of a material selected from the group consisting of stainless steel, tungsten, platinum, and nickel-titanium alloy (Col. 13, lines 26 – 30) and being connected to a source of radio-frequency electrical energy (Col. 5, lines 17 – 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the loop electrode as disclosed by Burbank et al. to include a material selected from the group consisting of stainless steel, tungsten, platinum, and nickel-titanium alloy and being connected to a source of radio-frequency electrical energy as taught by Bales et al. in order to simultaneously cut and cauterize the tissue during a tissue acquisition procedure (See Abstract).

### ***Conclusion***

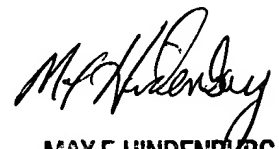
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JMLF

  
**MAX F. HINDENBURG**  
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